

REMARKS

Claims 1-51 were pending on the March 19, 2009 mailing date of the non-final Office Action. Claims 1-2, 13-15, 18-19, and 35-36 are being amended. Claim 52 is being added. Support for claim amendments and the new claims can be found in the specification, at least in paragraphs [0025] – [0069]. Reconsideration of the action and further consideration are respectfully requested.

Examiner Interview

The Applicant thanks Examiners Brandenburg and Bramer for the courtesy of a personal interview on April 8, 2009. The Applicant and the Examiners discussed the amended features of claim 1, namely the “transitioned” feature. The Examiners stated that a new search would be performed.

§ 112 Rejections

Claims 18-34 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Claim 18 recites “means for” and the Office Action states that “it is uncertain whether or not the Applicant is invoking 35 U.S.C. §112, sixth paragraph. Since there is no specific definition in the application’s specification of what is included as a ‘means for,’ 35 U.S.C. §112, sixth paragraph is not properly invoked.” The Applicant respectfully disagrees. Claim 18 recites “means for” and Applicant intends to invoke 35 U.S.C. § 112, sixth paragraph. Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only the structures or materials disclosed in the specification and "equivalents thereof" that correspond to the recited function. See MPEP 2106. Therefore, claim 18 is not indefinite because it is to be construed under 35 U.S.C. § 112, sixth paragraph.

§ 101 Rejections

Claims 1-51 were rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant reserves the right to re-present the claims at a future time in a continuing application. In order to expedite prosecution, claims 1 and 35 have been amended. Applicant believes the amended claims reflect statutory subject matter. Applicant respectfully requests withdrawal of the § 101 rejections.

§ 103 Rejections

Claims 1-12, 14-15, 18-29, 31-32, 35-46, and 48-49 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Publication No. 2003/0146939 ("Petropoulos"). Claims 13, 16, 30, 33, 47, and 50 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of U.S. Publication No. 2002/0165767 ("Ogura"). Claims 17 and 34 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of Ogura as applied to claims 13, 16, 30, 33, 47 and 50 above, and further in view of U.S. Publication No. 2002/0032677 ("Morgenthaler"). Claim 51 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Petropoulos in view of Morgenthaler. Applicant respectfully traverses the rejection.

Independent claim 1 recites "**delivering**, from a server at a first time, **a first electronic document including a first and second instance of an electronic advertisement**, the first instance being in a compact display format and including an associated expansion icon, the second instance being an expanded display format . . . wherein the electronic advertisement is **initially displayed to a user in the compact display format and is transitioned** from the compact display format **into** the expanded display format upon a first user selection of the expansion icon . . . receiving . . . a second user selection . . . after the electronic advertisement has been transitioned from the compact display format into the expanded display format . . . and **delivering** . . . at a second later time, **a second electronic document** including content from the referenced network location associated with the menu option selected and **including the electronic advertisement, wherein the electronic advertisement displayed with the second electronic document to the user is initially displayed in the expanded display format.**" The relied upon portions of Petropoulos fail to teach or suggest these claim features.

First, the search result page (nor any individual search result entry) displayed in the Petropoulos system is not “a first and second instance of an electronic advertisement,” as recited in claim 1. The Examiner states on page 54 of the Office Action that the search result of Petropoulos is “advertising a webpage, document, etc. to the user indicating the location of where the requested information can be found.” The relied upon portion of Petropoulos, however, does not teach or suggest that the search result page that is delivered includes both a first and second instance of a single advertisement. At most, the relied upon portion of Petropoulos describes that the preview information associated with the search result can *include* an advertisement but does not teach or suggest that the preview includes two instances of the same advertisement.

Second, the Office Action states that “the Examiner is interpreting the search results as disclosed in Petropoulos to be the first display format (i.e. compact). When that information is then previewed, content associated with that particular search result is displayed in a preview window, thus establishing the second display format (i.e., expanded). As per Petropoulos . . . this is done via instructions sent to the user’s web browser to render the content inline with the particular search result. Thus, the search result has been ‘transitioned’ via the disclosed instructions to an expanded format displayed in the preview window.” Applicant respectfully disagrees.

Petropoulos describes allowing a user to see both a search result and a preview of the underlying information described by the search result (i.e., a preview of the webpage linked to by the result). However, Applicant respectfully asserts that the relied upon portion of Petropoulos related to a search result and associated preview web page is not the same as Applicant’s claimed first and second instance of an advertisement nor transitioning from a compact display format into an expanded display format, as recited in claim 1. The relied upon portions indicate that a search result is delivered then a preview can be prompted. Even if this is construed as being Applicant’s claimed two instances, which point Applicant does not concede, there is not teaching or suggestion in the relied upon portions that two instances of an advertisement are delivered at a same time. Rather, as describe in the relied upon portions of the reference, the two different elements are delivered sequentially at two different times (i.e., at a first time the search result is delivered, then at a second time after the user has selected a particular result a preview is

delivered). For at least this reason alone, Applicant respectfully asserts that the relied upon portions of Petropoulos do not teach or suggest Applicant's claimed delivery of two instances of an advertisement.

Further, as discussed above the relied upon portions indicate that a search result is delivered then a preview can be prompted. Even if this is construed as being Applicant's claimed two instances, which point Applicant does not concede, there is not teaching or suggestion in the relied upon portions that two instances of an advertisement are transitioned as set forth in Applicant's claim. Rather, as describe in the relied upon portions of the reference, the two different elements are delivered sequentially at two different times (i.e., at a first time the search result is delivered, then at a second time after the user has selected a particular result a preview is delivered). Applicant respectfully asserts that there is no transition between the two instances as alleged by the Examiner. For this additional reason, Applicant respectfully asserts that the relied upon portions of Petropoulos do not teach or suggest Applicant's claimed transitioning of two instances of an advertisement as set forth in Applicant's claim.

Third, the Examiner agrees that Petropoulos does not teach or suggest "delivering, from the server, a second electronic document including content from the referenced network location associated with the menu option selected and including" the second electronic advertisement as recited in claim 1. *See* Office Action, page 11. The Office Action states "Petropoulos does teach enabling active hyperlinks in preview windows that when clicked result in a call to the referenced page as well as enabling further mouse-over, which allows the user to use mouse-over in the preview pane . . . it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Petropoulos to include delivering content associated with a selected menu option including the advertisement in the expanded display format . . . Furthermore, the Examiner notes that although Petropoulos does not explicitly teach what exactly occurs in the main browser window when they hyperlink in the preview window is selected, it would be an obvious design choice to program the browser to display in such a fashion as claimed in the instant application." *See* Office Action, page 12. Applicant respectfully disagrees.

The Examiner appears to be taking of Official Notice with regard to the "delivering" feature above by stating that Petropoulos does not teach the feature yet concluding that it would have been obvious to motify Petropoulos to include the claim feature. The Applicants refer the

Examiner to MPEP § 2144.03. In relevant part, MPEP § 2144.03 states, "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." Applicants submit that the Examiner has made a generalized statement without any documentary evidence to support it. Applicants traverse the Examiner's taking of "Official Notice," noting the impropriety of this action, as the Federal Circuit has "criticized the USPTO's reliance on 'basic knowledge' or 'common sense' to support an obviousness rejection, where there was no evidentiary support in the record for such a finding." See *id.* Applicants submit that "[d]eficiencies of the cited references cannot be remedied by ... general conclusions about what is 'basic knowledge' or 'common sense.'" In *re Lee*, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejection after considering the reasoning presented herein, Applicants submit that the Examiner must provide "specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge." In *re Soli*, 317 F.2d 941, 946, 137 USPQ 797, 801 (CCPA 1963).

The relied upon portions of *Ogura* and *Morgenthaler* also do not teach or suggest the claimed subject matter missing from *Petropoulos* namely "delivering, from a server at a first time, a first electronic document including a first and second instance of an electronic advertisement, the first instance being in a compact display format and including an associated expansion icon, the second instance being an expanded display format . . . wherein the electronic advertisement is initially displayed to a user in the compact display format and is transitioned from the compact display format into the expanded display format upon a first user selection of the expansion icon . . . receiving . . . a second user selection . . . after the electronic advertisement has been transitioned from the compact display format into the expanded display format . . . and delivering . . . at a second later time, a second electronic document including content from the referenced network location associated with the menu option selected and including the electronic advertisement, wherein the electronic advertisement displayed with the second electronic document to the user is initially displayed in the expanded display format."

Accordingly, the relied upon portions of *Petropoulos*, *Ogura*, and *Morgenthaler* taken alone or in combination, do not teach or suggest each and every element of claim 1, and

therefore, cannot support a rejection of this claim under 35 U.S.C. § 103(a). Reconsideration and withdrawal of the rejection are respectfully requested and deemed appropriate for at least these reasons. Claims 2-17 depend from claim 1 and are allowable for at least the same reasons set forth above with respect to claim 1.

Claim 18 is directed to an apparatus that includes an electronic advertisement output means for delivering at a first time a first electronic document including a first and second instance of an electronic advertisement, the first instance being in a compact display format and including an associated expansion icon, the second instance being an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, wherein the electronic advertisement is initially displayed to the user in the compact display format and is transitioned from the compact display format into the expanded display format upon a first user selection of the expansion icon associated with the first instance of the electronic advertisement. Claim 18 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 19-34 depend from claim 18 and are allowable for at least the same reasons set forth above with respect to claim 18.

Claim 35 is directed to an apparatus including a server for performing operations comprising delivering at a first time a first electronic document including a first and second instance of an electronic advertisement, the first instance being in a compact display format and including an associated expansion icon, the second instance being an expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option, wherein the electronic advertisement is initially displayed to a user in the compact display format and is transitioned from the compact display format into the expanded display format upon a first user selection of the expansion icon associated with the first instance of the electronic advertisement. Claim 35 is allowable for at least the same reasons set forth above with respect to claim 1. Claims 36-47 depend from claim 35 and are allowable for at least the same reasons set forth above with respect to claim 35.

New claim 52 is directed to a method including delivering a first electronic document including content and a first instance of an electronic advertisement, the first instance of the electronic advertisement including an associated expansion icon and being delivered in a compact display format; receiving a first user selection for the expansion icon associated with

first instance of the electronic advertisement; delivering a second electronic document replacing the first electronic document, the second electronic document including the content and a second instance of the electronic advertisement in an expanded display format, the expanded display format comprising one or more menu options and a reference to a network location for retrieving specified content associated with each menu option; receiving a second user selection of one of the one or more menu options; and delivering a third electronic document replacing the second electronic document, the third electronic document including content from the referenced network location associated with the menu option selected and including the second instance of the electronic advertisement in the expanded display format. Claim 52 is allowable for at least some of the same reasons set forth above with respect to claim 1.

Conclusion

For the foregoing reasons, the Applicant submits that all the claims are in condition for allowance. By responding in the foregoing remarks only to particular positions taken by the Examiner, the Applicant does not acquiesce with other positions that have not been explicitly addressed. In addition, the Applicant's selecting some particular arguments for the patentability of a claim should not be understood as implying that no other reasons for the patentability of that claim exist. Finally, the Applicant's decision to amend or cancel any claim should not be understood as implying that the Applicant agrees with any positions taken by the Examiner with respect to that claim or other claims.

Please apply any charges not otherwise paid or any credits to deposit account 06 1050.

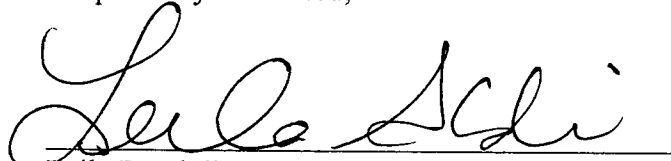
Applicant : Koningstein
Serial No. : 10/748,681
Filed : December 31, 2003
Page : 19 of 19

Attorney's Docket No.: 16113-0639001

Respectfully submitted,

Date: _____

5/12/09

A handwritten signature in black ink, appearing to read 'Leila R. Abdi', written over a horizontal line.

Leila R. Abdi
Reg. No. 52,399

Customer No. 26192
Fish & Richardson P.C.
Telephone: (404) 892-5005
Facsimile: (877) 769-7945

12096155.doc